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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,387	02/10/2004	Scott V. Taylor	AUS-2265-AL	3912

21378 7590 07/09/2009  
APPLIED MEDICAL RESOURCES CORPORATION  
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EXAMINER
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NGUYEN, TUAN VAN

ART UNIT	PAPER NUMBER
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3731

MAIL DATE	DELIVERY MODE
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07/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,387	<b>Applicant(s)</b> TAYLOR ET AL.	
	<b>Examiner</b> TUAN V. NGUYEN	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 47-55 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10, 11, 13, 14, 26-30 and 49-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 12, 15-25, 31, 47, 48 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/09, 12/17/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In previous Office action, claims 1-5, 7-9, 12, 15-25, 31, 47, 48, 54 and 64-66 were examined and rejected and claims 6, 10, 11, 13, 14, 26-30, 32-42, 43-46, 49-53, and 55-63 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.
2. This Office action is in response to the amendment filed on 03/06/2009.

### ***Response to Amendment/Arguments***

3. According to the amendment, claims 32-46, 56-63 and 67 have been canceled. Accordingly, claims 1-31 and 47-55 are pending in this present application, claims 1-5, 7-9, 12, 15-25, 31, 47, 48, and 54 are presented for examination and claims 6, 10, 11, 13, 14, 26-30, and 49-53 have been withdrawn.
4. With respect to the rejection of independent claims 1, 15, and 24 under 35 USC 103(a), Applicants' argue that the dynamic seal system of Sleister device needs the channel seal 72 to form an absolutely sealed when no surgical instrument is in the cannula 12, therefore, Gentelia and Sleister in combination do not disclose or suggest every feature recited in the independent claims. Examiner respectfully disagrees. Noting that Gentelia already discloses the device is capable to provide absolutely sealed when no surgical instrument is in the cannula. Examiner only relied on Sleister et al. for the teaching of the sealing member should be formed from a material that have compressibility and friction resistance (col. 8, lines 40-

45), for example, the surface of the dynamic seal member of a trocar device must be made from a single elastomer or combination of elastomers (col. 8, lines 39-44) to improve the sealing when an instrument is presented between the two sealing members. It would have been obvious to use the teaching of Sleister to improve the rollers of Gentelia by adding an elastomeric layer to the outside surface of the rollers to provide the sealing with or without presence of the instrument, thus, improving the efficacy of the device.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1-5, 7-9, 12, 15, 17-18, 21-25, 31, 47, 48, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentelia et al. (U.S. 5,201,714) in view of Sleister et al (US 5,522,831).**
8. Gentelia discloses (Figs. 1 and 4) a trocar comprising: a cannula having a proximal end and a distal end; a seal housing communicating with the cannula to define a working channel; a seal assembly disposed within the seal housing; and at least one roller included in the seal assembly and having an axle supported by the seal housing. Gentelia discloses the invention substantially as claimed except for the roller is a conformable roller that is dimensioned and configured for forming a tight seal in the absence of an instrument extending therethrough and for contacting with and conforming to an instrument thereby forming an instrument seal in the presence of the instrument extending therethrough. However, Sleister discloses (Figs. 7-9) in order to maintain sufficient pressure against the instrument to prevent gas leakage, the surface of the dynamic seal member of a trocar device must be made from a single elastomer or combination of elastomers (col. 8, lines 39-44). Therefore, it would have been obvious to use the teaching of Sleister to improve the rollers of Gentelia by adding an elastomeric layer to the outside surface of the rollers to provide the sealing with or without presence of the instrument, thus, improving the efficacy of the device.
9. Referring to claim **23**, Gravener discloses the invention substantially as claimed except for the housing and the roller are formed of translucent material. However, it is old and well known in the art that trocar housing and cannula are formed of

translucent or transparent material is for the purpose of providing the surgeons the ability to observe the tissue and the location of the distal tip of the instrument being inserted into the cavity. Extrinsic evidence, Frederick et al (US 6,017,356) discloses the trocar 40 is made from transparent material for the purpose of providing the surgeons the ability to observe the tissue (see Example 2).

10. **Claims 16, 19, 20, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentilia et al. and Sleister et al as applied to claims in view of De la Torre et al (US . 6,238,373).**
11. Gentilia as modified by Sleister discloses the invention substantially as claimed except for the resilient material is a gel material. However, De la Torre discloses such a material for his device (see col. 10, line 52 to col. 11, line 15 and Fig. 16-16a). Apparently the gel material provides a better compliant between the valve and the outer surface of the instrument thereby providing a better seal between the valve and the instrument. Therefore, it would have been obvious to one of ordinary skill in the art to include the gel material around the rollers of the modified device of Gentilia so that it too would have the same advantage.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./  
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
7/1/09